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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,141	11/07/2001	Gholam A. Peyman	42174	4651

1609 7590 12/15/2003

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WASHINGTON,, DC 20036

EXAMINER

SHAY, DAVID M

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 12/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on September 17, 2003

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133); Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3, 6-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-3, 6-14, 217-40 is/are rejected.

☒ Claim(s) 1415 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3, 6, 7, 9-14, 17, 18, 20-28, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neeffe ('604) in combination with Warner et al. Neeffe ('604) teaches a method such as claimed except the formation of a flap (note that steps predicated on the formation of a flap are also not taught). Warner et al teach the formation of a flap in a corneal recurving method. It would have been obvious to the artisan of ordinary skill to form a flap prior to the application of the mold and to apply the mold of Neeffe ('604) to the stroma, since this would spare the epithelium and heat the tissue that is actually desired to be recurved – stroma, thus producing a method such as claimed.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neeffe ('604) in combination with Warner et al as applied to claims 1-3, 6, 7, 9-14, 17, 18, 20-28, and 31 above, and further in view of Sand. Sand teaches the use of an infrared laser to heat the cornea in a corneal reshaping method. It would have been obvious to use the laser of Sand to heat the cornea in the method of Neeffe ('604) since the wavelength of Sand will provide penetrating heat which will be concentrated in the stroma, which is the layer of the eye desired to be heated, thus producing a method such as claimed.

Claims 2, 14, 18, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neeffe ('604) in combination with Warner et al as applied to claims 1-3, 6, 7, 9-14, 17, 18, 20-28, and 31 are above, and further in view of Kuznetz. Kuznetz teaches heating a body portion with an applicator that is heated by circulating fluid. It would have been obvious to the artisan of ordinary skill to employ a circulating fluid to heat the mold of Neeffe ('604), since this would

enable a predetermined temperature to be applied for a controllable period of time, thus producing a method such as claimed.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neeffe ('604) in combination with Warner et al as applied to claims 1-3, 6, 7, 9-14, 17, 18, 20-28 and 31 are above, and further in view of Berry et al. Berry et al teach producing thermocouples on the coupler to monitor the temperature of the cornea (see column 12, line 60). Thus it would have been obvious to the artisan of ordinary skill to employ thermocouples on the mold of Neeffe ('604) since this would allow the temperature of the cornea to be monitored, thus producing a method such as claimed.

Claims 32-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neeffe ('604) in combination with Warner et al as applied to claims 1-3, 6, 7, 9-14, 17, 18, 20-28, and 31 are above, and further in view of Kelman et al and Thompson et al. Kelman et al teach the equivalence of corneal onlays and corneal inlays. Thompson et al teach forming onlays with a mold. It would have been obvious to the artisan of ordinary skill to form the onlay of Thompson et al using the heated mold of Neeffe ('604), since any method can be used and to employ the formed element as an inlay, since these are equivalents, as taught by Kelman et al, thus producing a method such as claimed.

Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neeffe ('604) in combination with Warner et al, Kelman et al and Thompson et al as applied to claims 32-37 are above, and further in view of Kuznetz. The teachings of Kuznetz and the motivations for combination thereof are essentially those already iterated regarding claims 1-3, 6, 7, 9-14, 17,

18, 20-28, and 31. Thus it would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to produce a method such as claimed.

Claim 40 is rejected to under 35 U.S.C. 103(a) as being unpatentable over Neeffe ('604) in combination with Warner et al, Kelman et al, and Thompson et al as applied to claims 32-37 above, and further in view of Berry et al. The teachings of Berry et al and the motivations for combination thereof are essentially those already set forth regarding claims 18 and 19. Thus it would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to produce a method such as claimed.

Applicant argues that there is no teaching to heat the stroma rather than any other portion. The examiner must respectfully disagree. Neeffe ('604) specifically teaches that the material desired to be heated is the stroma (see column 2, lines 8-11). Thus this argument is not convincing.

Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed September 17, 2003 have been considered but are not persuasive for the reasons set forth above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Shay whose telephone number is (703) 308-2215. The examiner can normally be reached on Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0944.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Shay/DI

November 19, 2003



DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330